

RECEIVED
CENTRAL FAX CENTER

0001/005

BEST AVAILABLE COPY

JAN 7 2007

60130-2082; 03MRA0207

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Niebuhr et al.
Serial No.: 10/849,618
Filed: 05/19/2004
Art Unit: 1773
Examiner: Zacharia, Ramsey E.
Title: **COMPOSITE VEHICLE PART AND METHOD OF
MANUFACTURING A COMPOSITE VEHICLE PART**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Dear Sir:

In response to the new rejection set forth in the final Office Action of November 17, 2006, applicant requests consideration of the following arguments.

Claims 1-13 and 22-23 remain pending in the application. Claims 14-21 have been cancelled as being drawn to a non-elected invention.

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of Yamazaki (US 5989480). The examiner has admitted that AAPA does not disclose step (b) as defined in claim 1. However, the examiner argues that Yamazaki teaches this step and states that it would be obvious to modify AAPA to include this step. Applicant respectfully disagrees.

First, Yamazaki does not disclose, suggest, or teach the step of reworking a *removable protective foil* as defined in the claim. The insert film disclosed in Yamazaki is not a removable protective foil, and is instead a patterned decorative layer that forms a final part of the composite part itself. See col. 5, line 60 to col. 6, line 19.

Second, even if the film layer of Yamazaki can somehow be considered as corresponding to the claimed removable protective foil, Yamazaki does not teach "reworking" of such a

BEST AVAILABLE COPY

60130-2082; 03MRA0207

removable protective foil before the foil part, together with the removable protective foil, are placed in a die. The examiner argues that this is taught at col. 14, lines 56-67 of Yamazaki; however, this section merely states that the insert film is positioned within the mold under constant tension. This is not a "reworking" of the insert film, and one of ordinary skill in the art would not consider this tensioning of the Yamazaki insert film as corresponding to the claimed step of reworking. The tensioning of the insert film of Yamazaki is merely a part of the positioning step of placing the insert film in the die and does not itself constitute a "reworking" of the foil.

Finally, the examiner has argued that it would have been obvious to one of ordinary skill in the art to rework the foil of AAPA to smooth its surface before putting the foil in a die. As set forth at MPEP 2143, to establish a *prima facie* case of obviousness there must be some suggestion or motivation to modify the reference, there must be a reasonable expectation of success, and the reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant respectfully asserts that there is no motivation or suggestion to modify AAPA in the manner proposed by the examiner.

The identification of the problem and the discussion of the inventive solution are only found in applicant's disclosure. Applicant was seeking to provide a composite part, as claimed, which has an excellent surface quality such that there is visual compatibility with any adjacent painted parts so that the vehicle will have a uniform appearance. See paragraph [003]. As discussed in applicant's disclosure, providing the protective foil on the foil part, however, does not completely prevent surface damage of the foil part because any contaminants in the protective foil will create raised or thickened locations in the protective foil. These raised or thickened locations can be pressed into the foil part during subsequent back foaming or injection molding steps, making the surface quality of the foil part less than desirable. See paragraphs [0191]-[020]. To avoid the above-mentioned disadvantage, applicant's invention involves a reworking step that reworks the protective foil on its outer side before the foil part is back-foamed or injection-molded on its rear side. See paragraph [021].

BEST AVAILABLE COPY

60130-2082; 03MRA0207

As discussed above, Yamazaki does not disclose, suggest, or teach any type of reworking of a removable protective foil. There is also no discussion in Yamazaki of a problem with surface quality of a part to which the insert film of Yamazaki is attached. Further, there is no suggestion in Yamazaki that tensioning of an insert film within a die before it is attached to a part, such as that disclosed by Yamazaki, would be an appropriate solution for improving the surface quality of a composite body part, such as that of applicant's, which is covered by the removable protective foil. Thus, the only teaching and suggestion to make the claimed modification is found in applicant's disclosure, which cannot be used as the basis of a suggestion or motivation to make the modification.

With regard to the dependent claims, applicant submits the following remarks. Claim 3 recites that additional step of reshaping the foil part after step (b). The examiner argues that the pressure of back foaming causes at least some reshaping to conform the foil to the mold surface as in claim 3. Claims 3 recites reshaping of the *foil part*, which has an outer skin with the removable protective foil being disposed on a front side of the outer skin. Step (b) recites the step of reworking the removable protective foil to smooth a surface of the outer side, which is done before step (c). The reshaping of the foil part is done after step (b) as claimed. Thus, this is not a result of back foaming and applicant respectfully asserts that claim 3 is allowable for the additional reasons set forth above.

For the reasons set forth above, claim 4 is also allowable. Further, claim 4 recites the step of reshaping the foil part after step (a) and before step (b), which as defined in claim 1 is before step (c). The examiner argues that AAPA "suggests" the reshaping of claim 4. Applicant disagrees. AAPA does not suggest or teach the order of steps set forth in claim 4.

Claim 22 recites that step (a) is performed prior to step (b), and step (c) is performed prior to step (d). The examiner argues that AAPA "suggests" the order of the steps of 22. Applicant disagrees. Claim 22 requires the provision of a foil part with a removable protective foil disposed on a front side of the outer skin, wherein the removable protective foil has an outer side. Claim 22 then requires a subsequent reworking of the removable protective foil to smooth a surface of the outer side, which is followed in time by placing the foil part together with the

BEST AVAILABLE COPY

60130-2082; 03MRA0207

removable protective foil in a die subsequent to the reworking step, and which is followed in time by applying a plastic layer via a high-pressure process on a rear side of the outer skin.

AAPA does not suggest this order. Applicant respectfully requests an indication of where in AAPA this order is suggested. The examiner has admitted that AAPA does not disclose performing step (c) after step (b) and has relied on Yamazaki for this modification. As discussed above, applicant has disputed the teachings of Yamazaki as being relevant to a removable protective foil as claimed. However, even if the foil of Yamazaki can be construed as corresponding to the claimed removable protective foil, Yamazaki does not disclose, suggest, or teach "reworking" this foil after it has been attached to a foil part as defined in claim 22. The insert film of Yamazaki is "tensioned" prior to being attached to any type of part. See Figure 16. Thus, Yamazaki teaches away from the claimed order of steps by tensioning of the insert film prior to bonding the insert film to any other component or layer. As neither AAPA nor Yamazaki disclose, suggest, or teach the claimed order of steps, claim 22 is allowable over the recited combination.

Claims 12 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of Yamazaki (US 5989480), and further in view of Gossie (US 3970508). Claim 12 recites that step (b) includes polishing the removable protective foil on the outer side. The examiner argues that Gossie discloses smoothing the film by hand to remove wrinkles, referring to col. 1, lines 5-17. This section of Gossie merely recites that a decal is smoothed by hand with a squeegee to remove wrinkles.

First, a decal is not a removable protective foil as defined in the claims. A decal is included with the final part and is visible after final assembly. The decal is not a protective layer that is subsequently removed to show a final exterior surface of an underlying part. Second, smoothing with a squeegee cannot be reasonably construed as corresponding to the claimed "polishing" step. One of ordinary skill in the art simply would not consider using a squeegee to smooth out wrinkles in a decal as corresponding to the claimed step of polishing the removable protective foil of a composite part as defined in the claims. Thus, for the many reasons set forth above claim 12 is allowable over the recited combination.

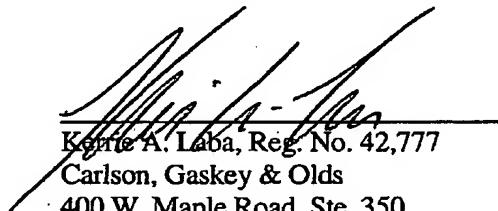
BEST AVAILABLE COPY

60130-2082; 03MRA0207

Claim 23 is allowable for the same reasons as claim 12. Further, claim 23 recites additional features including polishing the removable protective foil to provide a polished surface on the outer side, and placing the polished surface against a die surface. The examiner relies on Gossie to teach a polished surface as claimed, however, as discussed above the examiner's "surface" is a decal surface that is intended to be the visible surface of the part. There is no disclosure in any of the references of subsequently placing such a polished surface against a die surface as claimed.

Thus, for the reasons set forth above applicant asserts that all claims are now in condition for allowance and requests an indication of such. Applicant believes that no additional fees are necessary; however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

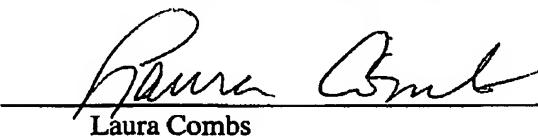
Respectfully submitted,



Kenne A. Laba, Reg. No. 42,777
Carlson, Gaskey & Olds
400 W. Maple Road, Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: January 17, 2007**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the United States patent and Trademark Office, fax number (571) 273-8300, on January 17 2007.



Laura Combs